

**REMARKS**

The present Amendment amends claims 1 and 6, and leaves claims 3-5 and 8 unchanged. Therefore, the present application has pending claims 1, 3-6 and 8.

**Claim for Foreign Priority**

Applicants filed a claim for foreign priority under 35 U.S.C. §119, claiming the right for priority based on Japanese Patent Application No. 2001-212365. The certified copy of the priority document was filed on March 11, 2002, and a review of Public PAIR indicates that the Office has received the document (see page 2 of "Certified Copy of Foreign Priority Application," with a mail room date of March 11, 2002). However, although the Examiner has acknowledged Applicants' claim for foreign priority, the Examiner has incorrectly indicated that the certified copy of the priority document has not been received (see item 12 of the Office Action Summary). Therefore, Applicants respectfully request the Examiner's acknowledgement of receipt of the certified copy of the priority document.

**35 U.S.C. §101 Rejections**

Claims 1 and 3-5 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter for failing to produce a concrete and tangible result. This rejection is traversed for the following reasons. Applicants submit that claims 1 and 3-5, as now more clearly recited, are directed to statutory subject matter. Specifically, independent claim 1 recites a method for operating a computer, where the method is operable on the computer to perform steps of the method. The claims, as amended, produce a concrete result because if one of ordinary skill performed the method, assured and repeatable results would occur. In addition, the claims, as amended, are tangible because at least one of the steps of the method

requires the use of hardware (i.e., a computer) to accomplish the step. Therefore, the present invention produces concrete and tangible results, and Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

### **35 U.S.C. §112 Rejections**

Claims 1, 2-6 and 8 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being incomplete for omitting essential steps, such omission accounting to a gap between the steps. As indicated in the Amendment filed on April 4, 2006, claim 2 was canceled. Therefore, this rejection regarding claim 2 is rendered moot. Regarding the remaining claims 1, 3-6 and 8, this rejection is traversed for the following reasons. As described in MPEP 2172, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). Accordingly, the Examiner is reminded to presume that the invention as set forth in the claims is what Applicants regard as their invention. Applicants submit that claims 1, 3-6 and 8, as now more clearly recited, do not omit essential steps, and are in compliance with the provisions of 35 U.S.C. §112.

### **35 U.S.C. §103 Rejections**

Claims 1, 3, 4, 6 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over ZipForm in view of U.S. Patent Application Publication No. 2002/0002566 to Gajraj, and further in view of U.S. Patent No. 6,904,412 to Broadbent. This rejection is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claims 1, 3, 4, 6, and 8, are not taught or suggested by ZipForm, Gajraj or Broadbent, whether taken individually or in combination with each other in the manner suggested by the

Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to the claims to more clearly describe features of the present invention. Specifically, the claims were amended to more clearly describe that the present invention is directed to an application preparation assisting method and system as recited, for example, in independent claims 1 and 6.

The present invention, as recited in claim 1, and as similarly recited in claim 6, provides an application preparation method and system for assisting in preparing an application for making a document-based application to a public organization. The method includes a step of acquiring information on a worldwide standard that defines contents that should be described in the application. The method also includes acquiring information on a standard unique to each country that is defined in detail in conformity with the worldwide standard, and acquiring information on published applications and examinations unique to each country. The method further includes accepting conditions associated with the application documents to be prepared and accepting a selected country, where the conditions and the country are specified by a user. Another step of the method includes assisting in the preparation of application documents based on the acquired information on the worldwide standard, information on the standard unique to each country, information on the published applications and examinations, and the conditions associated with the application documents to be prepared. The method also includes a step of examining the application documents to check whether any of the application documents include an item that violates examination criteria. Another step includes preparing and converting the application documents for the selected country to comply with an

application format and examination conditions in the country, such that none of the application documents include any item violating the examination criteria, including a quantity of a component in the application documents. The prior art does not disclose all these features.

The above described features of the present invention, as now more clearly recited in the claims, are not taught or suggested by any of the references of record. More specifically, the features are not taught or suggested by ZipForm, Gajraj or Broadbent, whether taken individually or in combination with each other.

ZipForm discloses a system and method for assisting in the preparation of the paperwork associated with a typical real estate transaction. However, there is no teaching or suggestion in ZipForm of an application preparation assisting method or system as recited in claims 1 and 6.

ZipForm's system and method assists in the preparation of paperwork associated with a typical real estate transaction. The completion of all the paperwork associated with a typical real estate transaction, such as listing and sales contracts, offers and counteroffers, disclosure statements, and countless other important documents, can be an extremely time-consuming task. The ZipForm method and system enables one to speed up the process by sharing data between all documents related to the same transaction. For example, a real estate agent can simply fill out one form and the information is automatically shared with all the forms required to complete a transaction. This system and method allows the agent to spend less time managing paperwork.

One feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of acquiring information on a worldwide standard

that defines contents that should be described in the application. As conceded by the Examiner, ZipForm does not disclose this feature. ZipForm relates to real estate transactions, and the ZipForm program allows the user to increase productivity and eliminate repetition in preparing real estate related forms. ZipForm does not disclose acquiring information on a worldwide standard, defining contents that should be described in the application, as claimed.

In response to Applicants arguments that ZipForm fails to teach acquiring information on a worldwide standard, which defines contents that should be described in the application, the Examiner asserts that "Applicant is arguing a limitation, which is not claimed by Applicant" (page 3 of Office Action). However, the Examiner's attention is directed to claim 1, lines 5-6, which recites "acquiring information on a world-wide standard with defines contents that should be described in said application". Therefore, contrary to the Examiner's assertions, this feature is claimed, and is not disclosed in any of the cited references. Furthermore, although in the rejection of claims 1 and 6, the Examiner appears to concede that ZipForm does not teach this feature (see page 7 of Office Action, where Examiner states that "ZipForm does not explicitly teach[] acquiring information on a world-wide standard which defines contents which should be described in said application"), the Examiner asserts in the Response to Arguments that ZipForm teaches acquiring information at a jurisdictional level, citing page 22. However, the cited text merely describes the use of the Internet as a delivery tool for real estate forms. This disclosed use of the Internet is not the same as acquiring information on a worldwide standard, in the manner claimed. Therefore, ZipForm does not teach or suggest the claimed feature.

Another feature of the present invention includes acquiring information on a standard unique to each country that is defined in detail in conformity with the worldwide standard, and acquiring information regarding published applications and examinations unique to each country. ZipForm does not disclose this feature. The Examiner concedes that ZipForm does not disclose acquiring information unique to each country, which is defined in detail in conformity with the worldwide standard. However, the Examiner asserts that ZipForm discloses acquiring information relating to published applications and examinations unique to each country. To support the assertion that ZipForm discloses this feature, the Examiner cites page 18 and states "set for form for South Dakota Area and Kokomo Area." First, South Dakota is a state and Kokomo is a city. These are not countries having a worldwide connotation as claimed. Furthermore, page 18 of ZipForm merely shows links to newly added libraries of forms added for the South Dakota Real Estate Commission and the Kokomo Area Association of Realtors. This is not information relating to published applications and examinations unique to each country, but rather are standard real estate forms unique to the South Dakota area and the Kokomo area.

In response to Applicants arguments that ZipForm does not teach acquiring information on a standard unique to each country, in the manner claimed, the Examiner asserts that ZipForm is "capable" of preparing documents for a plurality of countries to meet each country's own jurisdictional requirements (see page 3 of Office Action). More specifically, the Examiner asserts that ZipForm teaches preparing documents for a plurality of jurisdictions (i.e., a city and state), and therefore, ZipForm is capable of preparing documents for a plurality of countries. First, Applicants submit that ZipForm teaches away from preparing documents for a

plurality of countries. Real estate transactions are conducted under local and/or state laws. There are no global laws or worldwide laws for conducting real estate transactions. Therefore, there is no teaching or suggestion in ZipForm, which is specifically directed to real estate transactions, for preparing documents for a plurality of countries.

Furthermore, the Examiner is reminded that claims are to be given their ordinary and customary meaning. As such, the Examiner is further reminded that it is improper to interpret "country" as recited in the claims to have a much broader meaning, such as "jurisdiction". Applicants are not claiming acquiring information on a standard unique to each "jurisdiction, but rather are claiming acquiring information on a standard unique to each "country". The city and state disclosed in ZipForm are not countries. Therefore, ZipForm does not disclose the claimed feature.

Another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes accepting conditions associated with the application documents to be prepared and accepting a selected country, where the conditions and the country are specified by a user. ZipForm does not disclose this feature. For example, as previously discussed, ZipForm does not disclose acquiring information regarding a country. Therefore, it follows that ZipForm does not disclose accepting a selected country specified by a user, as claimed. Even further, ZipForm does not teach or suggest accepting condition associated with the application documents to be prepared, where the condition are specified by a user.

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes assisting in the preparation of application documents based on the acquired information on the worldwide standard,

information on the standard unique to each country, information on the published applications and examinations, and the conditions associated with the application documents to be prepared. As conceded by the Examiner, ZipForm does not disclose a step of assisting to prepare application documents.

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes a step of examining the application documents to check whether any of the application documents include an item that violates examination criteria. As conceded by the Examiner, ZipForm does not disclose a step of examining the application documents to check for violations.

Yet another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of preparing and converting the application documents for the selected country to comply with an application format and examination conditions in the country, such that none of the application documents include any item violating the examination criteria, including a quantity of a component in the application documents. As conceded by the Examiner, ZipForm does not disclose a step of preparing and converting the application documents.

Therefore, ZipForm fails to teach or suggest “acquiring information on a world-wide standard which defines contents that should be described in said application” as recited in claim 1, and as similarly recited in claim 6.

Furthermore, ZipForm fails to teach or suggest “acquiring information on a standard unique to each country which is defined in detail in conformity with said world-wide standard, and information on published applications and examinations unique to each country” as recited in claim 1, and as similarly recited in claim 6.



Further, ZipForm fails to teach or suggest “accepting conditions associated with the application documents to be prepared and accepting a selected country, wherein the conditions and the country are specified by a user” as recited in claim 1, and as similarly recited in claim 6.

Even further, ZipForm fails to teach or suggest “assisting to prepare said application documents based on said acquired information on the world-wide standard, information on the standard unique to each country, said information on the published applications and examinations, and said conditions associated with the application documents to be prepared” as recited in claim 1, and as similarly recited in claim 6.

Still even further, ZipForm fails to teach or suggest “examining said application documents to check whether any of said application documents include an item which violates examination criteria” as recited in claim 1, and as similarly recited in claim 6.

Yet even further, ZipForm fails to teach or suggest “preparing and converting the application documents for said selected country to comply with an application format and examination conditions in said country such that none of said application documents include any item violating said examination criteria including a quantity of a component in the application documents” as recited in claim 1, and as similarly recited in claim 6.

The above noted deficiencies of ZipForm are not supplied by any of the other references of record, namely Gajraj, whether taken individually or in combination with each other. Therefore, combining the teachings of ZipForm and Gajraj in the

manner suggested by the Examiner still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Gajraj discloses a tool for the transformation of marked-up documents using a base architecture. However, there is no teaching or suggestion in Gajraj of an application preparation assisting method or system as recited in claims 1 and 6.

Gajraj discloses a method of transforming a document and a method of populating a transformation table for transforming elements of a first document. In Gajraj, a first document is marked up according to a first document type definition is transformed into a second document marked up according to a second document type definition. The first document includes at least one element and contains a reference to the first document type definition. The method includes a step of determining from the first document type definition to which class of element an element in the first document belongs. The method also includes a step of determining for that class, at least one corresponding element in the second document type definition. The method further includes a step of including in the second document an instance of the corresponding element or elements. The above steps may be repeated for all elements in the first document. In the disclosed method, a single generic tool can be used for transformation between many different types of documents. It is particularly useful in environments where many and varied types of document type definitions (DTD) are in use, or where applications are tailored to use particular DTDs.

One feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of acquiring information on a worldwide standard that defines contents that should be described in the application. Gajraj does not

disclose this feature. To support the assertion that Gajraj discloses this feature, the Examiner cites paragraph [0004] and states, "Gajraj teaches a generic standard for DTDs called Standard Generalized Markup Language (SGML)." The Examiner further asserts that it would be obvious to combine Gajraj with ZipForm, stating "it is known to one of ordinary skill in the art . . . that Data Interchange Format was one of the world standard formats to transform data from a first document (MS Excel) to a second document (Lotus 123)." However, the disclosure of a world standard format used to transform data from MS Excel to Lotus 123 is quite different from acquiring information on a worldwide standard which defines contents that should be described in an application, as claimed. Gajraj does not relate to applications as in the present invention and further does not acquire information that defines contents to be described in an application, as in the present invention.

Another feature of the present invention includes acquiring information on a standard unique to each country that is defined in detail in conformity with the worldwide standard, and acquiring information regarding published applications and examinations unique to each country. Gajraj does not disclose this feature. To support the assertion that Gajraj teaches acquiring information on a standard unique to each country, which is defined in detail in conformity with the worldwide standard, the Examiner cites paragraph [0014], and states, "transforming a first document marked up according to a first document type definition, into a second document marked up according to second document type definition." However, there is no teaching or suggestion in Gajraj whatsoever of acquiring information on a standard unique to different countries, in the manner claimed. Furthermore, there is no

teaching or suggestion in Gajraj of acquiring information on published applications and examinations unique to each country, in the manner claimed.

Another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes accepting conditions associated with the application documents to be prepared and accepting a selected country, where the conditions and the country are specified by a user. Gajraj does not teach or suggest where a user specifies a country and conditions, in the manner claimed.

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes assisting in the preparation of application documents based on the acquired information on the worldwide standard, information on the standard unique to each country, information on the published applications and examinations, and the conditions associated with the application documents to be prepared. As conceded by the Examiner, Gajraj does not disclose a step of assisting to prepare application documents.

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes a step of examining the application documents to check whether any of the application documents include an item that violates examination criteria. As conceded by the Examiner, Gajraj does not disclose a step of examining the application documents to check for violations.

Yet another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of preparing and converting the application documents for the selected country to comply with an application format and examination conditions in the country, such that none of the application documents include any item violating the examination criteria, including a quantity of

a component in the application documents. As conceded by the Examiner, Gajraj does not disclose a step of preparing and converting application documents.

Therefore, Gajraj fails to teach or suggest “acquiring information on a world-wide standard which defines contents that should be described in said application” as recited in claim 1, and as similarly recited in claim 6.

Furthermore, Gajraj fails to teach or suggest “acquiring information on a standard unique to each country which is defined in detail in conformity with said world-wide standard, and information on published applications and examinations unique to each country” as recited in claim 1, and as similarly recited in claim 6.

Further, Gajraj fails to teach or suggest “accepting conditions associated with the application documents to be prepared and accepting a selected country, wherein the conditions and the country are specified by a user” as recited in claim 1, and as similarly recited in claim 6.

Even further, Gajraj fails to teach or suggest “assisting to prepare said application documents based on said acquired information on the world-wide standard, information on the standard unique to each country, said information on the published applications and examinations, and said conditions associated with the application documents to be prepared” as recited in claim 1, and as similarly recited in claim 6.

Still even further, Gajraj fails to teach or suggest “examining said application documents to check whether any of said application documents include an item which violates examination criteria” as recited in claim 1, and as similarly recited in claim 6.

Yet even further, Gajraj fails to teach or suggest “preparing and converting the application documents for said selected country to comply with an application format and examination conditions in said country such that none of said application documents include any item violating said examination criteria including a quantity of a component in the application documents” as recited in claim 1, and as similarly recited in claim 6.

The above noted deficiencies of ZipForm in view of Gajraj are not supplied by any of the other references of record, namely Broadbent, whether taken individually or in combination with each other. Therefore, combining the teachings of ZipForm in view of Gajraj and further in view of Broadbent, in the manner suggested by the Examiner still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Broadbent teaches a method and apparatus for a mortgage loan originator compliance engine. However, there is no teaching or suggestion in Broadbent of an application preparation assisting method or system as recited in claims 1 and 6.

Broadbent discloses an automated compliance engine that uses federal, state, local, and professional regulations and requirements and implements instructions for generating a plurality of tasks that can be used to control and drive the process of handling a mortgage loan application to completion. The compliance engine also monitors the completion of tasks in order to generate a completion certificate. Mortgage loan requesters may specify that the system will generate the plurality of required tasks, provide the plurality of required tasks to the requestor for execution, and monitor the completion of all required tasks, so as to provide a completion certificate to the requestor. Alternatively, loan requestors may specify

that the automated compliance engine generate the plurality of required tasks, transfer the required tasks to other systems qualified to manage and control the execution of the required tasks, and monitor the completion of all required tasks, so as to provide a completion certificate to the requestor.

One feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of acquiring information on a worldwide standard that defines contents that should be described in the application. Broadbent does not disclose this feature, and the Examiner does not rely upon Broadbent for teaching this feature.

Another feature of the present invention includes acquiring information on a standard unique to each country that is defined in detail in conformity with the worldwide standard, and acquiring information regarding published applications and examinations unique to each country. Broadbent does not disclose this feature, and the Examiner does not rely upon Broadbent for teaching this feature.

Another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes accepting conditions associated with the application documents to be prepared and accepting a selected country, where the conditions and the country are specified by a user. Broadbent does not teach or suggest where a user specifies a country and conditions, in the manner claimed.

Yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes assisting in the preparation of application documents based on the acquired information on the worldwide standard, information on the standard unique to each country, information on the published applications and examinations, and the conditions associated with the application

documents to be prepared. Broadbent does not disclose this feature. To support the assertion that Broadbent teaches a step of assisting in the preparation of application documents, the Examiner cites Figs. 7-12 and 33 and the accompanying text. However, the cited figures and text, or any other portions of Broadbent, fail to teach or suggest where assisting in the preparation of application documents is based on acquired information the worldwide standard, information on the standard unique to each country, information on the published applications and examinations, and the conditions associated with the application documents to be prepared, in the manner claimed.

Still yet another feature of the present invention, as recited in claim 1 and as similarly recited in claim 6, includes a step of examining the application documents to check whether any of the application documents include an item that violates examination criteria. Broadbent does not disclose this feature. To support the assertion that Broadbent teaches this feature, the Examiner cites the abstract and Figs. 7-12 and the accompanying text. However, the cited text and figures, or any other portions of Broadbent, fail to teach or suggest examining the prepared documents (i.e., the application documents), to determine if there are any violations of examination criteria. For example, as described in the column 8, lines 23-36, Broadbent merely discloses a system and method for managing the mortgage loan process. The automated system of Broadbent uses federal, state, local and professional regulations and requirements and implementing instructions to identify the set of tasks required to process a specific loan application, including tasks required by applicable federal and state law, to use, or provide this set of tasks to a lender to use, to drive the process of handling the specific mortgage loan application,



and to monitor and report the completion of the specified tasks as required by these regulations, or alternatively, that the required task completion may be traced to the completing entity. This system of monitoring the process of a loan application to ensure compliance with federal, state and local regulations by generating specific tasks, as required by the regulations, is not the same as examining prepared application documents for violations of examination criteria.

Yet another feature of the present invention, as recited in claim 1, and as similarly recited in claim 6, includes a step of preparing and converting the application documents for the selected country to comply with an application format and examination conditions in the country, such that none of the application documents include any item violating the examination criteria, including a quantity of a component in the application documents. Broadbent does not disclose this feature. To support the assertion that Broadbent teaches a step of preparing and converting the application documents, the Examiner cites the abstract. However, there is no teaching or suggestion in Broadbent of converting the application documents for the selected country to comply with an application format and examination conditions in the country. Furthermore, Broadbent fails to teach or suggest where the examination criteria include a quantity of a component in the application documents, as claimed. Accordingly, Broadbent does not teach the claimed feature.

Therefore, Broadbent fails to teach or suggest "acquiring information on a world-wide standard which defines contents that should be described in said application" as recited in claim 1, and as similarly recited in claim 6.

Furthermore, Broadbent fails to teach or suggest “acquiring information on a standard unique to each country which is defined in detail in conformity with said world-wide standard, and information on published applications and examinations unique to each country” as recited in claim 1, and as similarly recited in claim 6.

Further, Broadbent fails to teach or suggest “accepting conditions associated with the application documents to be prepared and accepting a selected country, wherein the conditions and the country are specified by a user” as recited in claim 1, and as similarly recited in claim 6.

Even further, Broadbent fails to teach or suggest “assisting to prepare said application documents based on said acquired information on the world-wide standard, information on the standard unique to each country, said information on the published applications and examinations, and said conditions associated with the application documents to be prepared” as recited in claim 1, and as similarly recited in claim 6.

Still even further, Broadbent fails to teach or suggest “examining said application documents to check whether any of said application documents include an item which violates examination criteria” as recited in claim 1, and as similarly recited in claim 6.

Yet even further, Broadbent fails to teach or suggest “preparing and converting the application documents for said selected country to comply with an application format and examination conditions in said country such that none of said application documents include any item violating said examination criteria including a quantity of a component in the application documents” as recited in claim 1, and as similarly recited in claim 6.

ZipForm, Gajraj and Broadbent suffer from the same deficiencies, relative to the features of the present invention, as recited in the claims. Therefore, combining the teachings of ZipForm, Gajraj and Broadbent in the manner suggested by the Examiner does not render obvious the features of the present invention as now more clearly recited in the claims. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 3, 4, 6, and 8 as being unpatentable over ZipForm in view of Gajraj, further in view of Broadbent are respectfully requested.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over ZipForm in view of Gajraj, further in view Broadbent, and even further in view of U.S. Patent No. 5,557,515 to Abbruzzese, et al. ("Abbruzzese"). This rejection is traversed for the following reasons. Claim 5 is dependent on claim 1. therefore, Applicants submit dependent claim 5 is allowable for at least the same reasons discussed above regarding independent claim 1.

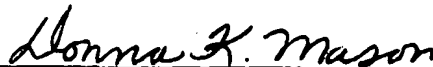
The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 1, 3-6 and 8.

In view of the foregoing amendments and remarks, Applicants submit that claims 1, 3-6 and 8 are in condition for allowance. Accordingly, early allowance of claims 1, 3-6 and 8 is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. 500.41210X00).

Respectfully submitted,

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